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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,509	12/18/2003	Frederick W. Ryan Jr.	F-730-O1	1508
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PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			EXAMINER VETTER, DANIEL	
			ART UNIT	PAPER NUMBER
			3628	
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			10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,509	Applicant(s) RYAN ET AL.	
	Examiner Daniel P. Vetter	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3628

DETAILED ACTION

Status of the Claims

1. Claims 1-29 were previously pending in this application. Claims 1-13 were canceled; claims 14, 21, and 26 were amended; and new claims 30-32 were added in the response filed August 10, 2007. Claims 14-32 are currently pending in this application.

Response to Arguments

2. Applicant's amendment to claim 26 overcomes the objection made to this claim and it is withdrawn.

3. Applicant argues on page 5 of the remarks that Montgomery does not teach newly added claim limitations. This argument is unpersuasive because applicant has not provided a reasoned analysis comparing the alleged deficiencies of the reference to the language of the claims. Montgomery teaches this limitation at least at ¶ 0168, wherein the reference discloses that a negative print success indicator is in response to a failure of the printing process even though the postage was issued. Additionally, it would be inherent that every print success indicator would be in response to something, either a failed printing or a completed printing.

4. In response to applicant's argument on page 6 of the remarks that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Art Unit: 3628

5. Applicant argues on page 7 of the remarks that "Montgomery '148 teaches away from the combination by explicitly stating that the system described necessarily only works with 100% positive tracking ID scanning." This argument is unpersuasive because the nature of this teaching does not preclude the combination of McFiggans with this reference. MPEP § 2145 X.D. Moreover, applicant's contention is a mischaracterization of the explicit teachings in ¶ 0083 of Montgomery, which ends by stating: "the unique identifier can be advantageously used to detect postal fraud in a non-stand-alone verification system even if 100% of the mail pieces are not scanned" (emphasis added).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 14-17, 21-24, 28, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery, et al., U.S. Pat. Pub. No. 2003/0220887 (Reference A of the PTO-892 part of paper no. 20070502).

8. As per claims 14 and 21, Montgomery, et al. teaches a method for detecting fraud by a user of a shipping label [and transportation item] having an identifier comprising: receiving a print success indicator for the shipping label having a first identifier [and associated with the transportation item] (¶ 0127), wherein the print success indicator comprises a response or a default indication if no response is

Art Unit: 3628

received within an allocated response time period (§ 0168); receiving a list of identifiers representing items processed by [and used in] a shipping stream (§ 0083); if the print success indicator is negative, reporting a potential fraud if the first identifier is present in the list of identifiers (§§ 0168, 0176); and if the print success indicator is positive, reporting a potential fraud if the first identifier is present at least twice in the list of identifiers (§ 0109).

9. As per claims 15 and 22, Montgomery, et al. teaches the methods of claims 14 and 21 as described above. Montgomery, et al. further teaches the list of identifiers is received periodically (§ 0117).

10. As per claims 16 and 23, Montgomery, et al. teaches the methods of claims 14 and 21 as described above. Montgomery, et al. further teaches the list of identifiers comprise identifiers recognized for a period of time (§ 0086).

11. As per claim 17, Montgomery, et al. teaches the method of claim 15 as described above. Montgomery, et al. further teaches the list of identifiers is received daily (§ 0117).

12. As per claim 24, Montgomery, et al. teaches the method of claim 22 as described above. Montgomery, et al. further teaches the identifiers comprise identifiers from a plurality of sets of identifiers (§ 0087).

13. As per claim 28, Montgomery, et al. teaches the method of claim 21 as described above. Montgomery, et al. further teaches the transportation item is an item selected from the group: envelopes, post cards, postage labels, labels and packages (§ 0081).

14. As per claim 29, Montgomery, et al. teaches the method of claim 21 as described above. Montgomery, et al. further teaches the identifiers are selected from at least one set of identifiers wherein the set of identifiers includes one or more from the group: planet codes, delivery confirmation numbers, IBI indicia, identifiers including the combination of a piece count and permit number, and identifiers including the combination of a meter number and ascending register (§ 0095).

Art Unit: 3628

15. As per claims 30-32, Montgomery, et al. teaches the method of claim 14 as described above. Montgomery, et al. further teaches the identifiers are selected from at least one set of identifiers comprising planet codes (§ 0140); identifiers including the combination of a meter number and ascending register (§§ 0008, 0083); and identifiers including the combination of a piece count and permit number (§ 0083; examiner is interpreting a postage vendor ID as a permit number).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al.

18. As per claims 18 and 25, Montgomery, et al. teaches the methods of claims 16 and 23 as described above. Montgomery, et al. further teaches the list of identifiers comprises identifiers recognized during the prior one year (§ 0086). Montgomery, et al. does not teach the time period is the prior six months. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the time period is the prior six months into the method taught by Montgomery, et al. because this is merely an optimized range of time. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Art Unit: 3628

19. Claims 19, 20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al. in view of McFiggans, et al., U.S. Pat. No. 6,032,138 (Reference B of the PTO-892 part of paper no. 20070502).

20. As per claims 19 and 26, Montgomery, et al. teaches the methods of claims 15 and 22 as described above. Montgomery, et al. does not teach reporting a potential fraud if an identifier having a successful print indicator is not recognized within an expected package period. McFiggans, et al. teaches reporting a potential fraud if an identifier having a successful print indicator is not recognized within an expected package period (column 2, lines 56-60). It would have been prima facie obvious to incorporate the above teachings of McFiggans, et al. into the method taught by Montgomery, et al. in order to automatically feed back information on undelivered mail (as taught by McFiggans, et al., column 2, line 60).

21. As per claims 20 and 27, Montgomery, et al. in view of McFiggans, et al. teaches the methods of claims 19 and 26 as described above. Montgomery, et al. further teaches the expected package period is one period selected from the group of one day, one week, one month and six months (§ 0169).

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

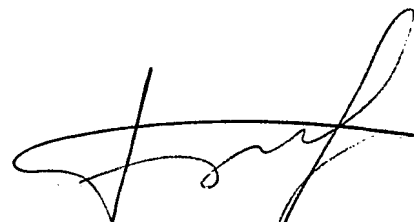
Art Unit: 3628

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a stylized, flowing script.

IGOR N. BORISSOV
PRIMARY EXAMINER